REMARKS

Applicants have studied the Office Action dated July 12, 2005, and have made amendments to the claims. Claims 1, 6, 10, 15, 19, and 24 have been amended. Claims 1-27 remain pending in the application. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested. Applicants submit that the application, as amended, is in condition for allowance. In the Office Action, the Examiner:

- Rejected claims 1-8, 10-17, and 19-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0188854 A1 to Heaven et al.; and
- Rejected claims 9, 18, and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/0188854 A1 Heaven et al. in view of U.S. Patent Publication No. 2002/0174125 to Lucovsky et al.

Overview of the Present Invention

The present invention provides a system and method for dynamically extending a Digital Rights Management (DRM) system using authenticated external Digital Property Rights (DPR) modules. In recent years, technology advances have allowed the practical copying of digital multi-media data sets onto writable media or the communications of these data sets among numerous people. As a result an increase in the copying, pirating, and unauthorized sharing of digitized multi-media presentations has occurred. Various techniques have been used to try to prevent unauthorized copying of multi-media presentations. The data set that comprises the multi-media presentation referred to as the media data set, is encrypted using the various techniques known in the art. Encryption of the media data set has limited effectiveness since the equipment that "plays back" or presents the multi-media presentation to a user must decrypt the media data set to allow playback, thereby requiring dissemination of the encryption technique to all product manufacturers.

The commercial grade encryption techniques are also subject to development of decryption algorithms. The encryption technique used for video DVDs, for example,

has been compromised by public release of a decryption algorithm used in DVD players. The publicly owned base of existing DVD players precludes changing the encryption algorithms used for that media once an encryption technique is compromised. Encryption protection by itself in existing player systems is also limited to authorizing access to the media data set and is not able to provide flexible limitations on the types of usage rights that may be granted to the media data set. Different types of usage rights that an owner of a media data set is interested in controlling include the right to modifying the data, immediate access to the entire media data set instead of progressive access over the course of the multi-media presentation, or access to permit deletion of parts of the media data set. Encryption of other types of data, such as a database or financial document, similarly fails to provide the ability to control the type of accesses or usages that may be authorized for the data.

Alternative protection techniques have been developed which support controlling different types of usage rights for a media data set. These systems, referred to as DRM Systems, are able to restrict access to data sets by limiting authorization to one or more types of usages of a data set in response to specified usage conditions. Access control in these systems is controlled through specified DPRs. An example of a DPR is a right to only read a particular media data set for a specified number of times. Such a DPR may be used to provide a free or low cost demonstration of the multi-media data set. Existing systems support a variety of conditions on usage of the media data set and those conditions may be specified on a remote license server, but the available types of usages that may be authorized are fixed by the implementation and may not be flexibly varied by the owners of the copyright on a media data set.

To overcome the problems in the prior art, the present invention, as recited for the amended claims, retrieves a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module. The at least first associated digital property rights module resides in a Digital Rights Management core and the at least second associated digital property rights module is an associated extension rights control module that is separate

from the Digital Rights Management core. The present invention identifies the associated extension rights control module specified in the digital property rights list for generating an authorization for a desired type of access to a data set. The present invention also requests the authorization for the desired type of access to the data set through the associated extension rights control module. The authorization is received from the associated extension rights control module if a set of usage conditions for the desired type of access is satisfied. The desired type of access is granted in response to receipt of the authorization.

No new matter has been added. Support for this amended language is found in the application as originally filed and particularly at page 8, lines 10-17 and page 8, lines 5-28 to page 10, lines 1-13.

Rejection under 35 U.S.C. §102(e) as being anticipated by Heaven.

As noted above, the Examiner rejected claims 1-8, 10-17, and 19-26 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0188854 A1 to Heaven et al. Referring to claims 1 and 19, the Examiner at page 3 of the office action states that Heaven discloses "*the controlling access to a data set by identifying an associated extension rights control module and generating of authorization for desired type of access to a data set and this being separate from DRM module see Par. 0022 & Par. 0020 & Par. 0003; the requesting the authorization for desired access see FIG. 1 item 24; receiving and granting the authorization from module if set usage conditions are satisfied see Par. 0020 & Par. 0026.*" However, the Applicant has amended claims 1 and 19 to more clearly and distinctly recite "retrieving a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in a Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core".

Nowhere does Heaven teach "retrieving a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in a Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core". In fact, Heaven teaches that a local rights cache only contains encrypted media files that have been previously downloaded from a biometric rights management server and an encrypted user profile. The user profile lists the media files assigned to a particular user, the rights associated with their use of the media, and the scope, terms, and limitations of that use. See Heaven at paragraph [0020]. Nowhere, does Heaven teach that the digital property rights list identifies even a single associated digital property rights module that is to be used to verify satisfaction of a specified set of usage conditions required for each usage right.

The present invention, on the other hand, allows for the available types of usages that may be authorized to be flexibly varied by the owners of the copyright. The available types of usages are not fixed and can be extended or added on to by the incorporation of digital property rights modules. In other words, by using digital property rights control modules, especially modules that are separate from the Digital Rights Management core, usage rights can be updated.

Furthermore, Heaven only teaches a local rights module and a biopassword module. See Heaven at FIG. 1. The local rights module of Heaven only controls access to the local rights cache, serves as a client-server communications manager for facilitating communications between the user computer system and the biometric rights management server. The local rights module also activates the biopassword module when necessary to verify or authorize rights to particular media files. The local rights module does not verify authorization of a specified set of usage conditions required for each usage right. See Heaven at paragraph [0021]. In other words, Heaven does not teach "requesting the authorization for the desired type of access to the data set

through the associated extension rights control module; receiving the authorization from the associated extension rights control module if a set of usage conditions for the desired type of access is satisfied" as recited for claims 1, 6, 10, 15, 19, 24. Heaven teaches that the biopassword module is the only module that verifies or authorizes rights for a particular media file.

Therefore, Heaven does not teach, anticipate, or suggest "retrieving a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in a Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core" as recited for claims 1 and 19.

The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Heaven.[1] Because the elements in independent claims 1 and 19 of "retrieving a digital property rights list identifying at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in a Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core" is not taught or disclosed by Heaven, Heaven does not identically describe each and every element of claims 1 and 19. Accordingly, claims 1 and 19 distinguish over Heaven for at least these reasons. The

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[1] See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 102(e) has been overcome and the rejection should be withdrawn.

Independent claims 6, 10, 15, and 24 have also been amended to incorporate similar language as amended into independent claims 1 and 19 discussed above. Therefore, the above arguments with respect to independent claims 1 and 19 are applicable here in support of the allowability of independent claims 6, 10, 15, and 24 and will not be repeated. Accordingly, claims 6, 10, 15, and 24 9 distinguish over Heaven for at least the reasons stated above.

For the foregoing reasons, independent claims 1, 6, 10, 15, 19, 24 as amended distinguish over Heaven. Claims 2-5, 7-8, 11-4, 16-17, 20-23, and 25-27 depend from claims 1, 6, 10, 15, 19, 24 respectively. Since dependent claims contain all the limitations of the independent claims, claims 1, 6, 10, 15, 19, 24 distinguish over Heaven, as well, and the Examiner's rejection should be withdrawn.

Rejection under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claims 9, 18, and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2002/0188854 A1 Heaven et al. in view of U.S. Patent Publication No. 2002/0174125 to Lucovsky et al. Regarding independent claims 6, 15, and 24, the above arguments with respect to Heaven are applicable here and will not be repeated.

As the Examiner correctly states on page 6, Heaven does not disclose the use of XML. The Examiner goes on to combine Heaven with Lucovsky.[2] The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is

[2] Applicants make no statement whether such combination is even proper.

giving full recognition to the invention "as a whole." The Heaven reference taken alone or in view of Lucovsky simply does not suggest, teach, or disclose the patentably distinct claim elements of:

> accepting a rights request to a data set, wherein the data set is associated with a digital property rights list specified in a rights management language, wherein the digital property rights list identifies at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in the Digital Rights Management core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the Digital Rights Management core;
>
> [...]

The limitations taken "as a whole" in amended independent claim 6 and similarly amended independent claims 15 and 24 are not present in Heaven taken alone or in view of Lucovsky.

Lucovsky teaches a messaging data structure for accessing data in an identity-centric manner (See Lucovsky at Abstract) and is completely silent on"

> accepting a rights request to a data set, wherein the data set is associated with a digital property rights list specified in a rights management language, wherein the digital property rights list identifies at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in the DRM core...

as recited for amended claim 6 and similarly for amended claims 15 and 24.

The present invention, unlike Lucovsky, allows for the available types of usages that may be authorized to be flexibly varied by the owners of the copyright. The available types of usages are not fixed and can be extended or added on to by the incorporation of digital property rights modules. In other words, by using digital property rights control modules, especially modules that are separate from the Digital Rights Management core, usage rights can be updated.

Accordingly, claims 6, 15, and 24 distinguish over Heaven alone and/or in combination with Lucovsky for at least this reason.

Further, when there is no suggestion or teaching in the prior art for "accepting a rights request to a data set, wherein the data set is associated with a digital property rights list specified in a rights management language, wherein the digital property rights list identifies at least a first associated digital property rights module and at least a second associated digital property rights module, wherein the at least first associated digital property rights module resides in the DRM core, and wherein the at least second associated digital property rights module is an associated extension rights control module that is separate from the DRM core...the suggestion cannot come from the Applicants' own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

For the foregoing reasons, independent claims 6, 15, and 24 as amended distinguish over Heaven taken alone and/or in view of Lucovsky. Claims 9, 18, and 27 depend from claims 6, 15, and 27 respectively. Since dependent claims contain all the limitations of the independent claims, claims 9, 18, and 27 distinguish over Heaven taken alone and/or in view of Lucovsky., as well, and the Examiner's rejection should be withdrawn.

CONCLUSION

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No Previously Presented matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully Submitted,

Date: September 9, 2005

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